

REMARKS

The application was originally filed with claims 1-22. In the current response, claims 9 and 18 have been canceled, and claims 6, 7, 16, 19, and 20 have been amended. Accordingly, claims 1-5, 8, 10-17 and 19-22 are pending and at issue.

Interview Summary

On March 14, 2005, applicant's attorney, Matthias Abrell, held a telephonic interview with examiner Robyn Kieu Doan to discuss the disposition of claim 20, as it was only addressed in the Office Action Summary, but not in the body of the Office Action. The examiner stated that claim 20 was rejection as obvious over U.S. Patent No. 5,228,465 ("Hill") in view of GB 2167946 (Lowery).

Response to the Specification/Drawing objections

Applicant has amended Figure 1 to include reference numeral "33" indicating the first side of the body, as described in the specification. As a result, no new matter is added by the drawing amendment. The amended drawing reflecting these changes is enclosed herewith as a "Replacement Sheet."

Response to the §112 rejections

Applicant respectfully traverses the rejection of claims 4, 7, 14, and 17 as indefinite under §112. More specifically, the examiner rejected the claims based on the use of the trademark name VELCRO "because the material being used in the trademark name can be changed with time." Applicant respectfully submits that even though VELCRO is a trademark name, it is known to have specific structure to those of ordinary skill in the art. Therefore, even if the material used in the trademark changes over time, one of ordinary skill in the art will always know what structure VELCRO comprised at the date of invention of the current application.

Response to the §102 rejections

Applicant respectfully traverses the rejection of claims 19, 21 and 22 as anticipated under §102(b) by *Hill*. Applicant respectfully submits that *Hill* fails to disclose each and every element of the amended claims and, therefore, fails to anticipate any of the rejected claims.¹ As a result, applicant respectfully requests withdrawal of these rejections.

Specifically, claim 19 as amended recites “opening a body of a hair straightening device, the body including a first portion including an inner surface having a plurality of bristles.”

Hill does not disclose a first portion having bristles. In fact *Hill* does not disclose the use of bristles at all. In particular, *Hill* discloses a clamp having a front portion 16 connected to a rear portion 18 with a resilient liquid-absorbing liner 14 disposed there between.

Therefore, because *Hill* does not disclose a first portion having bristles, applicant respectfully submits that *Hill* fails to anticipate claim 19 and its dependent claims 21 and 22.

Response to the §103 rejections

Applicant respectfully traverses the rejection of claims 1, 2, 5, 8, 10-12, 15 and 20 as obvious over *Hill* in view of *Lowery*. Applicant respectfully submits that the combination of *Hill* and *Lowery* fails to provide any motivation for combining the references to arrive at the rejected claims.²

Hill disclosed a hair clamp 10 having an outer shell 12 and a resilient liquid-absorbing liner 14. The liner 14 is preferably made from a liquid absorbing polyurethane foam or similar material. (Column 4, lines 4-5). In use, a quantity of known hair relaxing solution is applied directly to the hair and/or to the foam liner 14 and the clamp 10 is closed such that the two halves of the foam liner 14 are compressed and maintain the hair in a straight position. (Column 4, lines 43-49). After sufficient time has elapsed to provide sufficient depolymerization of the hair protein, the clamp 10 is removed by simply pulling it off the hair. (Column 4, lines 35-52). As a result, the liner 14 is necessary to accomplish the

¹ "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Rockwell International Corp. v. United States*, 47 USPQ2d 1027 (Fed. Cir. 1998).

intended purpose of straightening the hair by pressing it between the halves of the liner 14 to apply the hair relaxing solution.

Lowery discloses a hair treatment device having a handle 3 and brush sections 4, 5 disposed at ends thereof. The brush sections 4, 5 each include clumps of bristles 6.

Neither *Hill* nor *Lowery*, however, provide any motivation for substituting *Lowery*'s bristles for *Hill*'s liner. *Hill* teaches compressing hair and applying a relaxing solution via the liner. A person of ordinary skill in the art would not be motivated to substitute *Lowery*'s bristles that are less effective on both compressing hair and applying a relaxing solution.

The mere fact that references can be modified is not sufficient to establish a prima facie case of obviousness. See Section 2143.01 of the M.P.E.P., which states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)" (emphasis original). The applicant, therefore, respectfully submits that the obviousness rejection of claims 1, 11 and 20 and their respective dependent claims be withdrawn.

Applicant additionally traverses the remainder of the obvious rejections over *Hill* in view of *Lowery* further in view of one of GB 2371744 ("*Rajwani*"), U.S. Patent No. 3,871,388 ("*Leoci*"), and U.S. Patent No. 3,692,032 ("*Regas*"). Applicant respectfully submits that no combination of *Hill* and *Lowery* with any of *Rajwani*, *Leoci*, or *Regas* provides any motivation for combining the references to arrive at the rejected claims, as any combination of *Hill* with a reference that discloses bristles renders the prior art unsatisfactory for *Hill*'s intended purpose. The applicant, therefore, respectfully submits that the remainder of the obviousness rejections be withdrawn.

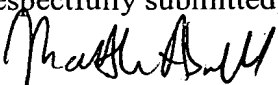
² "To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Application No.: 10/656,743
Amendment dated July 8, 2005
Reply to Office Action of March 8, 2005

CONCLUSION

In view of the above discussion, applicant submits that each of the presently pending claims is in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue.

Dated: July 8, 2005

Respectfully submitted,
By: 
Matthias Abrell
Registration No.: 47,377
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive, Suite 6300
Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant